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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/965,345	09/26/2001	Ronald Quan	M-2096-4C US	9110
24251	7590	09/29/2004	EXAMINER	
SKJERVEN MORRILL LLP 25 METRO DRIVE SUITE 700 SAN JOSE, CA 95110			LANIER, BENJAMIN E	
			ART UNIT	PAPER NUMBER
			2132	

DATE MAILED: 09/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**RECEIVED**  
**OCT 13 2004**  
**Technology Center 2100**

**Office Action Summary**

Application No.

09/965,345

Applicant(s)

QUAN, RONALD

Examiner

Benjamin E Lanier

Art Unit

2132

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 21 September 2001.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 105-116 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 105-116 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 September 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Response to Amendment***

1. Applicant's cancellation of claims 1-104 and addition of claims 105-116 has been fully considered and is entered.

***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Regarding claims 107-110, 113-116, the phrase "range of about" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 105-116 are rejected under 35 U.S.C. 102(b) as being anticipated by Buynak, U.S. Patent No. 5,394,470. Referring to claims 105, 106, 111, 112, Buynak discloses a method of augmenting a video signal wherein augmenting pulses are added to the horizontal sync pulse intervals of a video signal to prevent a copy of the modified video signal (Abstract), which meets the limitation of adding a pulse to a selected position in a back porch region following a horizontal sync pulse of the copy protected video signal. The augmenting pulses can have a

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negative amplitude, which meets the limitation of adding a pulse having a selected negative amplitude.

Referring to claims 107-110, 113-116, Buynak discloses that the augmenting pulses have a width of at least .5 ms (Col. 10, lines 40-42), which meets the limitation of negative pulses having a width in the range of 1 to 2 ms, and the augmenting pulses have a approximate amplitude of -40 IRE units (Col. 10, lines 43-45), which meets the limitation of the negative pulses in the range of about -10 to -20 IRE units.

### ***Double Patenting***

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 1-12 of patent #6,501,842 contain every element of claims 105-116 of the instant application and as such anticipate claims 105-116 of the instant application.

8. "A later patent claim is not patentably distinct from an earlier patent claim if the later claim is obvious over, or **anticipated by**, the earlier claim. *In re Longi*, 759 F.2d at 896, 225 USPQ at 651 (affirming a holding of obviousness-type double patenting because the claims at issue were obvious over claims in four prior art patents); *In re Berg*, 140 F.3d at 1437, 46

USPQ2d at 1233 (Fed. Cir. 1998) (affirming a holding of obviousness-type double patenting where a patent application claim to a genus is anticipated by a patent claim to a species within that genus). “ ELI LILLY AND COMPANY v BARR LABORATORIES, INC., United States Court of Appeals for the Federal Circuit, ON PETITION FOR REHEARING EN BANC (DECIDED: May 30, 2001).

***Conclusion***

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Benjamin E Lanier whose telephone number is 703-305-7684.

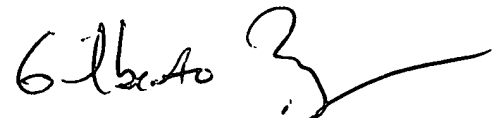
The examiner can normally be reached on M-Th 7:30am-5:00pm, F 7:30am-4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barron can be reached on (703)305-1830. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Benjamin E. Lanier



GILBERTO BARRON  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100

#2

U.S. Department of Commerce, Patent and Trademark Office		Atty Docket No.	Serial No.
		M-2096-4C US	Unknown
INFORMATION DISCLOSURE STATEMENT BY APPLICANT		Applicant(s)	
(Use several sheets if necessary)		Ronald Quan	
		Filing Date	Group
		Herewith	Unknown

11036 U.S. PTO  
09/965345  
09/26/01

U.S. Patent Documents							
*Examiner Initial		Document Number	Date	Name	Class	Subclass	Filing Date If Appropriate
BL	AA	4,475,129	10/1984	Kagota	380	204	
BL	AB	4,631,603	12/23/86	Ryan	358	335X	
BL	AC	4,695,901	09/22/87	Ryan	380	204	
BL	AD	4,819,098	04/04/89	Ryan	360	37.1	
BL	AE	4,928,309	05/22/90	White	380	15	
BL	AF	4,951,315	08/21/90	Switsen	380	15	
BL	AG	5,130,810	07/14/92	Ryan	358	310	
BL	AH	5,133,008	07/21/92	Fujita	380	5	
BL	AI	5,157,510	10/20/92	Quan et al.	380	15	
BL	AJ	5,194,965	03/16/93	Quan et al.	380	5X	
BL	AK	5,633,927	05/27/97	Ryan et al.	380	5	

Foreign Patent Documents							
							Translation
		Document	Date	Country	Class	Subclass	Yes No
BL	AL	88 12 594.7	10/04/88	DE			
BL	AM	189 548	11/28/85	EP			
BL	AN	WO 91/16791	10/31/91	PCT			
	AO						

OTHER ART (Including Author, Title, Date, Pertinent Pages, Etc.)		
BL	AP	"MACROVISION DECODER/BLANKER", Elektor Electronics, 14 October 1988, pp 44-47
BL	AQ	"Report of Special Master" U.S. District Court, case No. C-99-20011 EAI, Northern District of California, 15 pgs.
BL	AR	"Order Adopting and Approving Report of Special Master" U.S. District Court, case No. C-99-20011 EAI, Northern District of California, 13 pgs.
	AS	

Examiner <i>Big E. J.</i>	Date Considered <i>9/22/04</i>
*EXAMINER Initial if reference considered, whether or not citation is in conformance with MPEP 609; Draw line through citation if not in conformance and not considered. Include copy of this form with your communication to applicant.	

<b>Notice of References Cited</b>	Application/Control No. 09/965,345	Applicant(s)/Patent Under Reexamination QUAN, RONALD	
	Examiner Benjamin E Lanier	Art Unit 2132	Page 1 of 1

**U.S. PATENT DOCUMENTS**

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Name	Classification
	A	US-5,394,470	02-1995	Buynak et al.	380/204
	B	US-6,501,842	12-2002	Quan, Ronald	380/204
	C	US-			
	D	US-			
	E	US-			
	F	US-			
	G	US-			
	H	US-			
	I	US-			
	J	US-			
	K	US-			
	L	US-			
	M	US-			

**FOREIGN PATENT DOCUMENTS**

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Country	Name	Classification
	N					
	O					
	P					
	Q					
	R					
	S					
	T					

**NON-PATENT DOCUMENTS**

*		Include as applicable: Author, Title Date, Publisher, Edition or Volume, Pertinent Pages)
	U	
	V	
	W	
	X	

\*A copy of this reference is not being furnished with this Office action. (See MPEP § 707.05(a).)  
Dates in MM-YYYY format are publication dates. Classifications may be US or foreign.